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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,096	03/26/2004	Nancy A. Dulzer	MBC-0518	9732
23575 7590 10/12/2007 CURATOLO SIDOTI CO., LPA 24500 CENTER RIDGE ROAD, SUITE 280 CLEVELAND, OH 44145			EXAMINER MARCANTONI, PAUL D	
			ART UNIT 1793	PAPER NUMBER
			MAIL DATE 10/12/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/811,096

Applicant(s)

DULZER ET AL.

Examiner

Paul Marcantoni

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2007 and 22 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47-57 and 90 is/are pending in the application.
- 4a) Of the above claim(s) 1-46 and 58-89 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47 and 90 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-90 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 5/23/05 and 5/6/04

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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The applicants' 4/2/07 and 8/22/07 responses to the restriction and election requirements are acknowledged.

Restriction and Election:

Election:

Applicants elected inorganic pigments, iron oxide (as specific pigment), and bentonite (as thixotropic additive). Applicants' argue that an election of species is not necessary as they allege there is a reasonable number of species and not a serious burden. The applicants are vague and do not define exactly what they mean by *reasonable* since the markusch group includes about 23 different inorganic pigments species and "any" combination of mixtures thereof not to mention organic pigments as well. Apparently, applicants believe this is a reasonable number which would not be a serious burden. This could potentially be true if the examiner had a week or more to examine their application but that's the point. Examiners do not have that time and the number of species itself and mixtures shows that the election was made because it is indisputable that it is a serious burden. It is also noted that the an election requirement is not traversable like a restriction because if the examiner cannot find a species he must move on to the next one nonetheless.

Restriction:

Applicant's election with traverse of Group III, claims 47-57 and 90 in the reply filed on 4/2/07 is acknowledged. The traversal is on the ground(s) that the inventions are unrelated does not hold. This is not found persuasive because the inventions are unrelated paragraph may or may not apply but "intermediate final product" certainly

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does with respect to Groups I and III and restriction is proper. It is also noted that claim 1 from Group I has no requirement that a "thixotropic additive" is part of said composition either whereas it is a requirement in Group III invention. Note that the examiner already stated that Groups I and II (method of making colored cement and colored cement were restrictable but could later be rejoined and essentially because of In re Ochiai these groups are ultimately or will ultimately become one Group. Thus, intermediate-final product can still apply to Groups I and/or II. A liquid coloring composition can be used to color virtually any other material including plastics, paint, inks, cosmetics, detergents, etc. and this is indisputable. It is relevant to the restriction. However, should applicants still wish these Groups combined, they can simply state for the record that Groups I and III are "obvious variants" and the Groups will be rejoined. This is not a serious burden on applicants' part to state so and should not be a problem. However, if the examiner finds Group III, he will also find Groups I and II as obvious in light of applicants' admission. By refusing to state for the record Groups I and III or all Groups for that matter are obvious variants, they would be only strengthening the examiner's position that a restriction is proper. This should not be too difficult for applicants to state for the record and satisfies all parties involved since applicants would get Groups I and III (and ultimately II as well) examined together and the so called "serious burden" on the examiner would be removed. The examiner respectfully awaits applicants reply with the words *obvious variants* for Groups I and III as part of their next response and the restriction will be withdrawn. If they do not state these words, the requirement is still deemed proper and is therefore made **FINAL**.

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35 USC 102/103:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 47-57 and 90 are rejected under 35 U.S.C. 102(a, b, and e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Farrington et al. '174 A1, Moreau et al. '106 B2 or '770 B1, Vickers Jr. et al. '143 B1, Bury et al. '814 B1 or '873 A1, O'Brien et al. '939 or '435, Marshall et al. '292, or Bown et al. (applicant supplied reference WO 97/10208).

Farrington teaches a composition comprising polycarboxylate dispersant (claim 1) and "at least one of pumping aids (inclusive of thixotropic additive) and pigments (see claim 10) thus anticipating applicants' claims. Even if not anticipated, overlapping ranges would have been prima facie obvious to one of ordinary skill in the art.

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Moreau '106 B2 or '770 B1 teaches a cement composition comprising cement and a polycarboxylate dispersant and metakaolin (reads on thixotropic additive-see claim 13) thus anticipating applicants' claims. Further, even if not anticipated, the addition of a pigment is common and conventional in the art (See MPEP 2144.03 c) should applicants challenge examiner on adding a pigment to cement/concrete, he will gladly supply a reference should they request such evidence).

Vickers Jr et al. '143 B1 teach a composition comprising polycarboxylate dispersant. The addition of pigments are conventional for the purposes of coloring and would have been an obvious design choice for one of ordinary skill in the art. Also, the addition of a thixotropic additive or thickening agent is also a conventional additive for the purposes of controlling suspension or slurry properties especially with relation to pumping or transport.

Bury et al. '814 B1 or '873 A1 teach a composition comprising a polycarboxylate dispersant (claim 1, col.15-16) and a pigment. The addition of a thixotropic additive or thickening agent is also a conventional additive for the purposes of controlling suspension or slurry properties especially with relation to pumping or transport.

O'Brien et al. '435 or '939 teach a composition comprising polycarboxylate dispersant, pigment, and extender (eg clay or Kaolin) thus anticipating applicants' claims. Even if not anticipated, overlapping ranges of amounts would have been prima facie obvious to one of ordinary skill in the art.

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Marshall et al. '292 teach a liquid dishwashing detergent composition comprising polycarboxylate dispersant (col.12, lines 5-8), thickening or thixotropic agent (col.4, lines 20-60), and pigments (col.14, line 49) thus anticipating applicants' claims.

Bown et al. (WO 97/10308) teach a composition comprising polycarboxylate dispersant and pigment. Bown would not appear to teach a thixotropic additive to his suspension yet the addition of a thickener or thixotropic aid to control the properties of a suspension or slurry especially with respect to properties such as pumpability are conventional or common in the art.

35 USC 103:

Claims 47-57 and 90 are rejected under 35 U.S.C. 103(a) as obvious over Farrington et al. '174 A1, Moreau et al. '106 B2 or '770 B1, Vickers Jr. et al. '143 B1, Bury et al. '814 B1 or '873 A1, O'Brien et al. '939 or '435, Marshall et al. '292, or Bown et al. (applicant supplied reference WO 97/10208) alone or in view of Gleeson '697 B2, McCurrich et al., Carpenter et al. '336, and Harris '990.

All of the above cited references teach a composition comprising polycarboxylate dispersant. Gleeson teaches that the addition of thickeners (same as thixotropic agent) and pigments are conventional and common additives to cement and thus their addition to the cement compositions of the primary references would have been an obvious design choice for one of ordinary skill in the art (col.5, line 25). Also, the use of a specific pigment would have been obvious to one of ordinary skill in the art depending upon such factors as desired color or opacity. The applicants listing of additives to cement in claim 57 are all conventional or common additives to cement and their

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addition would have been an obvious design choice for one of ordinary skill in the art. Retarders and accelerators are commonly used cement additives. Further, Gleeson teaches adding foaming agents like applicants thus meeting this claim limitation (see col.5, line 26)

McCurich et al. teach a composition comprising a pumpable cement and a gelling agent which is a thixotropic agent as it controls thickness of slurry or suspension. Adding a thixotropic agent to a cement or any other slurry to control thixotropy/thickness properties of the slurry or suspension is old and conventional in the art.

Carpenter teaches that hectorite is a known conventional additive to cement compositions as a thixotropic aid and its addition to cement for this purpose would have been an obvious design choice for one of ordinary skill in the art (col.3, lines 65-67). Harris teaches that the addition of such common additives as retarders and accelerators are conventional in the art (see bottom of col.3 and top col.4). Both of these additives to the cements of the primary references would thus have been obvious to one of ordinary skill in the art.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Marcantoni
Primary Examiner
Art Unit 1755